Supreme Court, U.S.
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No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1989

JAMES CONSTANT

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC.

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Pro se petitioner

QUESTIONS PRESENTED FOR REVIEW

1. Does selling parts bar the infringement of a patent by computer systems created using the parts, where the seller instructs the infringing computer structure and function and program kits in his technical literature.

2. Does a court's determination that a patent is not infringed render moot the dispute as to patent's validity.

3. Must a reason be given before references can be combined to support the obviousness of making an invention.

4. Absent a statutory bar, can the petitioner's own patent be 'prior art' to him.

5. Can a patented device not previously before the court, which includes structures but not functions of a patented device previously litigated in another court, require determination on its own facts.

6. In the present and earlier litigations involving the same parties, does a first patent which has been declared invalid by another court in the earlier litigation create a collateral estoppel barrier in the present litigation without giving the patentee-petitioner a chance to demonstrate that he did not have a full and fair chance to litigate his first patent in the earlier case.

7. Is a combination of references, prohibited under any subsection of 35 USC 102, prior art for purposes of 35 USC 103.

8. In the determination of prior art under 35 USC 102, for purposes of 35 USC 103, must a comparison of the claimed invention with the disclosure of each cited reference be made to determine the number of claim limitations in common with each reference and, is a given reference prior art when it has

nothing in common with any claim limitation.

9. In an obviousness analysis, is identity of function, between the claimed invention and prior art, required absent which consideration of structure should not be made.

10. Can references used to obviate a patent be applied without considering the prior art as a whole.

11. Whether the combination of references used against the 660 Patent suggest the claimed first-in-J-out (FIJO) time reversal and time compression functions of a filter.

12. Whether the court's conclusion that "The level of ordinary skill in the art is that of an engineer with a BSEE who has had several years experience in the field of digital electronics" is error because it is not based on any factual inquiry of the factors determining the level of ordinary skill.

13. Whether the secondary evidence of infringement of a patent must be considered before the decision on obviousness of the patent is reached and, thus, whether the court's conclusion that "The objective evidence does not support a finding of non-obviousness" is error because it was made before the infringement of the 660 Patent by AMD's 7910/11 and 79C12/14 devices was determined.

14. Whether petitioner was given the opportunity to show that in fact the 660 Patent is infringed by AMD's 7910/11 and 79C12/14 devices and to thereby establish commercial success that makes the invention not obvious.

15. Whether the doctrine of file wrapper estoppel is not applicable where literal infringement has been found and the patentee does not rely upon the doctrine of equivalents.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the Judgement of the United States Court of Appeals for the Federal Circuit dated 5 October, 1989 attached as APPENDIX A-2.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its Judgement attached as APPENDIX A-2 affirming the Orders and Judgement of the District Court Northern District of California attached as APPENDIX B holding two patents not infringed and one patent is invalid.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

STATEMENT OF THE CASE

Petitioner contends that respondent, Advanced Micro-Devices, Inc. (hereinafter referred to as "AMD") infringes Patent No. 4,006,351 (hereinafter referred to as "351" Patent) by AMD's 29300 and 29500 family devices. Compl. Exh D; infringes Patent No. 4,080,660 (hereinafter referred to as "660" Patent) by AMD's 29300,29500,7910/11, 79C12/14 devices. Compl. Exh. E; and infringes Patent No. 4,107,458 (hereinafter referred to as "458" Patent) by AMD's 9568, 9518, 8068 devices. Compl. Exh. F.

AMD requested summary judgement that it does not infringe the 351 and 660 Patents by AMD's 29300 and 29500 family devices. Petitioner requested summary judgement that AMD infringes the 351 and 660 Patents by AMD's 29300 and 29500 family devices. The district court held for AMD. B-2.

AMD requested summary judgement that

the 660 Patent is invalid for obviousness under 35 USC 103, since it incorporates the same invention the CAFC has already held invalid. * At bench trial, AMD relied on the Constant Patent No. 3,950,635 (hereinafter referred to as the "635" Patent), the article by Springer "High Speed Shift Registers use TTL RAMs and Counters to do All the Shifting", and the Bird Patent No. 3,553,651 (hereinafter referred to as the "651" Patent). The district court held for AMD. B-10.

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* In Constant v. AMD, 7 USPQ2d 1057,1061-65, the CAFC found petitioner's Patent No. 4,438,491 ("491" Patent) anticipated and obvious considering Intel specification sheet Exhibit 5, and the CAFC found petitioner's Patent No. 3,950,635 ("635" Patent) anticipated and obvious considering the Allen & Westerfield ("A&W") article (Journal of the Acoustical Society of America, Vol 36, No 1, Jan 64), Patent No. 3,295,107 ("107" Patent) to Stalcup, and the article by Springer, infra.

The CAFC denied petitioner's motion to file a supplement to the amended brief already filed. A-3. Thus, due to the 50 page rule of the CAFC for filing briefs, petitioner was denied from making a full argument on appeal which responds to the district court's finding that the collateral estoppel effects of the earlier case Constant v. AMD, 7 USPQ2d 1057 (CAFC 1988) apply to the present case.

Petitioner requested summary judgement that AMD infringes the 660 Patent by AMD's 7910/11,79C12/C14 devices. Since the district court held the 660 Patent invalid, it did not adjudicate this request. B-22.

AMD requested summary judgement that it does not infringe the 458 Patent. Petitioner requested summary judgement that AMD infringes the 458 Patent by AMD's 9568, 9518,8068 devices. The district court held for AMD. B-21.

REASONS FOR GRANTING THE WRIT

I. The 351 and 660 Patents are Infringed by AMD's 29300 and 29500 Family Devices.

The 29300 and 29500 familes consist of parts used to create computer systems. The structures and functions of systems are shown throughout AMD's technical literature (identified in petitioner's motions for summary judgement DN=46,48) (Docket Number hereinafter referred to as "DN").

1. Infringement of the 351 Patent

AMD infringes the 351 Patent because the 29300 and 29500 systems compute and multiply identical functions in identical means described in elements 1,4,5 of Fig 1a of the 351 Patent. For identity of structure see EXHIBITS 1,2,3 in DN 46. For identity of functions see EXHIBITS 4, 5,6,7 in DN 46. As shown in EXHIBITS 2

through 7 in DN 46, a number of 29300 and 29500 systems were built and tested by AMD. For identification of 29300 and 29500 systems throughout AMD's technical litirature, for identification of 29300 and 29500 systems actually built by AMD see page 4 in DN 46. As shown in EXHIBIT 1 of DN 46, the literal terms of claim 1 of the 351 patent read on the first and second means of the 29300 and 29500 systems.

The preamble of claim 1 of the 351 Patent is in Jepson format. A Jepson format preamble is not part of a claim. 37 CFR 1.75(e).

Claims of the 351 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof".

The 29300 and 29500 systems infringe claim 1 of the 351 Patent because every function of the claimed combination is performed by each accused system, the structures performing those functions being identicals or equivalents of the structures disclosed in the 351 Patent, literally or equivalently under 35 USC 112 paragraph 6. Pennwalt Corp. v. Durand-Wayland, Inc., 4 USPQ2d 1737 (CAFC 1987).

2. Infringement of the 660 Patent

AMD infringes the 660 Patent because the 29300 and 29500 systems read signals from a random access memory ("RAM") in the same or time reverse sequence as signals are written into the RAM, in identical means described in elements 7 and 11 of Fig 2 of the 660 Patent. For identity of structure see EXHIBITS 1,2,3 in DN 48. For identity of function see

EXHIBITS 4,5,6,7 in DN 48. As shown in EXHIBITS 2 through 7 in DN 48, a number of 29300 and 29500 systems were built and tested by AMD. For identification of 29300 and 29500 systems throughout AMD's technical literature, for identification of 29300 and 29500 systems actually built by AMD see page 4 in DN 48. As shown in EXHIBIT 1 of DN 48, the literal terms of claims 1,2,4 of the 660 patent read on the storing and addressing/shifting means of the 29300 and 29500 systems.

Claims of the 660 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof".

The 29300 and 29500 systems infringe claims 1,2,4 of the 660 Patent because

every function of the claimed combination is performed by each accused system, the structures performing those functions being identicals or equivalents of the 660 Patent, literally or equivalently under 35 USC 112 paragraph 6. Pennwalt, supra.

3. The Court's Order (B-2) is Error

The Court's order holding that the 351 and 660 Patents are not infringed by AMD's 29300 and 29500 families (B-2) is error because the preponderance of the evidence establishes that these systems infringe each patent directly, by inducement, and by contribution. The following facts, which respond to the individual findings by the court (B-4 through B-7), create genuine issues of material facts which preclude summary judgement for AMD.

1. The sale of parts does not bar direct infringement when "operable assemblies" of parts are made and tested by AMD enabling it to deliver the patented combination to its customers. Paper Converting Machine Co. v. Magna-Graphics Corp., 220 USPQ 591,597 (CAFC 1984). AMD admits that each part of the 29300 and 29500 families has been fully tested by AMD and, each system could be built by customers for a wide number of applications. See AMD's response to petitioner's 2nd admissions requests No 19 (DA 2-19); DA 3-23 (DN 52). AMD admits except for multipliers, none of the other parts from AMD's 29300 and 29500 families is individually capable of implementing algorithms. See AMD's answer to petitioner's Interrogatories

3rd set No 2 (DI 3-2)(DN 52). * AMD's technical literature states that the 29300 and 29500 families have been developed to provide systems. See EXHIBIT 4 (Chapter 1 Introduction, Chapter 3 Array Processing Algorithms, Chapter 4 Systems Design)(DN 52). In effect, AMD sells parts that can only be used in systems it instructs in its technical literature

a. Direct Infringement

AMD stipulates that the 29300 and 29500 systems are made, used and sold by AMD. See AMD letters to petitioner 1/12/89 and 1/18/89 attached to reply to AMD's opposition (DN 62).

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* In Constant v. AMD, 7 USPQ2d 1057,1063 Intel sold individual 2920 chips which could be used in combination with other chips to create computer systems. Since the SP20 kit for programming the 2920 chips was publicly available for infringing as well as non-infringing programs, the 2920 system (distinct from 2920 part) was held by the CAFC to anticipate and obviate petitioner's Patent No. 4,438,491

The evidence shows that AMD makes, uses and sells the 29300 and 29500 systems. p 10 APP A INSTR (DN 51). A number of systems were built and tested by AMD to support systems sales. See p 4 DN 46,48 for identification of systems actually built and tested by AMD in EXHIBITS 4,5,6 (DN 52); see letter 12/16/88 from AMD to petitioner (DN 52). The evidence also establishes that AMD makes, uses and sells the 29C300 system Evaluation Board to support its systems sales. p 5-1, Fig 5-1 EXHIBIT 5 (DN 52).

b. Inducement and Contribution

AMD induces and contributes to the infringement through its instructions contained in its technical literature. See pp 15-16 APP A INSTR (DN 51). AMD's technical literature provides and instructs how to make and use 29300 and 29500 systems.

See systems identified at p 1 in APP A INSTR (DN 51). Systems are specially designed for programs implementing infringing algorithms (FFT,IIR,FIR, division, multiplication). pp 9-24 EXHIBIT 4 (DN 52). See also pp 10-16 APP A INSTR (DN 51). * AMD's technical literature provides and instructs the infringing algorithms computed by the 29300 and 29500 systems. p 11 APP A INSTR (DN 51). AMD's technical literature provides and instructs the hardware and software tools used to program the

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* Fig 1a in the 351 Patent shows how the claimed recursive filter implemented as a matched clutter filter is obtained by computing two FFT's, one division, and one multiplication. Fig 2 in the 660 Patent shows how the claimed digital time scale inversion system is computed in a convolution (FIR) filter

infringing algorithms into the 29300 and 29500 systems. pp 11-12 APP A INSTR (DN 51). See also AMD's admissions at pp 17-20 APP A INSTR (DN 51). AMD admits (1) that systems made up of parts from AMD's 29300 and 29500 families could be designed in such a manner to implement algorithms (FFT,IIR,division, FIR)(DI 3-2)(DN 52), (2) that hardware and software kits are available in the marketplace and that such products can be used to program the 29300 and 29500 systems. DA 2-14; DA 2-15;DA 3-18 (DN 52), (3) that specific programs for computing the FFT,IIR, division,multiplication and FIR algorithms of the 351 and 660 Patents can be developed using the hardware and software tools. DA 2-16;DA 3-20 (DN 52), (4) that the 29300 and 29500 systems could be programmed to compute a large number of algorithms including the FFT,IIR,divide,multiply,and

FIR algorithms. DA 2-17;DA 3-21 (DN 52), (5) that AMD has communicated with third parties to make and use hardware and software support tools. DA 3-25(a) (DN 52), (6) that AMD provides hardware and software tools and kits. See Chapter 5 in EXHIBIT 5 (DN 52); see p 11 in APP A INSTR (DN 51). In short, AMD's customers buy the individual parts and then create their systems by following AMD's instructions for creating systems and programs using hardware and software tools and kits contained in AMD's technical literature.

2. Theoretically, a large number of systems could be built out of parts from AMD's 29300 and 29500 families. However, the claim limitations require certain structures. The 29300 and 29500 systems are specially designed for infringing structures. See EXHIBITS 1,2,3 in DN 46, 48. These structures are shown throughout

AMD's literature. See systems identified at p 1 APP A INSTR (DN 51). No structures other than the infringing structures are shown in AMD's literature. Further, while any computer can theoretically be programmed for an infinite number of possible algorithms, the claim limitations require certain algorithms (FFT,IIR,FIR,division, multiplication). The 29300 and 29500 systems are specially designed for computing infringing algorithms. See Chapter 3 EXHIBIT 4 (DN 52). No programs other than the infringing programs (FFT, IIR,FIR,division,multiplication) are shown in AMD's literature. Moreover, infringement cannot be avoided by the fact that an accused device has additional elements or functions not found in the patented device. *

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* (note continued on next page)

(note continued from previous page)

* Cochrane v. Deener, 94 US 780, 786, 24 LEd 139 (Modification by mere addition of elements or functions cannot negate infringement); Eastern Rotorcraft Corp. v. U.S., 184 Ct Cl 709, 397 F2d 978,981, 154 USPQ 43,45, 158 USPQ 294, later proceeding 194 Ct Cl 1042 (infringement not avoided by adding an additional element); McCullough Tool Co. v. Well Surveys, Inc., 343 F2d 381,402, 145 USPQ 6,22 (CA10 Okla), cert den 383 US 933, 15 L Ed2d 851, 86 S Ct 1061, 148 USPQ 772, reh den 384 US 947, 16 LEd2d 545, 86 S Ct 1452 and reh den 385 US 995, 17 LEd2d 455, 87 S Ct 593 (infringement not avoided by performing additional functions); Acme Highway Products Corp. v. D.S.Brown Co., 473 F2d 849,855,177 USPQ 130, 135 (CA6 Oh) cert den 414 US 824, 38 LEd2d 57, 94 S Ct 125, 179 USPQ 321 (An accused device cannot escape infringement by merely adding features). Foregoing cases cited in Amstar Corp. v. Envirotech Corp., 730 F2d 1476, 221 USPQ 649, 653 (CAFC 1984) cert den (US) LEd2d 240, 105 S Ct 306, 224 USPQ 616.

Radio Steel & Mfg Co. v. MTD Products, Inc., 221 USPQ 657,663-64 (CAFC 1984)(accused device that contains same feature as patented device cannot escape infringement because in it that feature performs additional functions it does not perform in patented device); Hayes Spray Gun Co. v. E.C.Brown Co., 291 F2d 319, 129 USPQ 383 (CA9 Cal)(The addition of an element to a patent structure does not avoid infringement).

3. The 351 Patent is infringed by 29300 and 29500 systems which can be programmed to constitute the claimed recursive filter implemented as a matched clutter filter. Fig 1a in the 351 Patent shows how the claimed recursive filter as a matched clutter filter is obtained by computing two FFT's, one division, and one multiplication. The 29300 and 29500 systems are specially designed for programs implementing infringing algorithms (FFT,IIR,FIR,division, multiplication). pp 9-24 EXHIBIT 4 (DN 52). See Also pp 10-16 APP A INSTR (DN 51).

4. The fact that individual parts of the 29300 and 29500 systems do not constitute a recursive filter implemented as a matched clutter filter is not relevant. Petitioner does not accuse that any individual part from AMD's 29300 and 29500 families constitutes a recursive filter implemented as a

matched clutter filter. Rather, petitioner accuses that systems created using parts form AMD's 29300 and 29500 families can be programmed to constitute a recursive filter implemented as a matched clutter filter. See DN 46; see footnote page 13 supra.

5. AMD admits and the evidence shows that it makes, uses and sells systems (see 1a supra) but denies that it programs for infringing use. Theoretically, a computer can be programmed to perform any function. Pennwalt, supra. However, the claim limitations require the performance of specified functions (FFT,IIR,FIR,division, multiplication). The 29300 and 29500 systems are specially designed for computing these functions. See Chapter 3 EXHIBIT 4 (DN 52). The following factors have relevance to the issue of computer programs (a) the existence of hardware and software tools and kits for

implementing programs and (b) the relevance of programs to the claimed invention. Constant, supra 1063. AMD admits that hardware and software tools are available in the marketplace and that such products can be used to program the 29300 and 29500 systems to implement algorithms (FFT,IIR, division,FIR), DI 3-2;DA 2-14;DA 2-15; DA 3-18 (DN 52). Moreover, programs for the FFT,IIR,division,FIR are relevant to the 351 and 660 inventions. See footnote page 13 supra.

6. Inducement occurs because AMD sells products capable of infringing use through its instructions contained in its technical literature. Chisum 17.04(4)(f) Note 19 and Supplement citations (numerous decisions find active inducement where a defendant selling products capable of infringing use provides through labels, advertizing or other sales methods instructions and directions as to the infrin-

ging use); Moleculon Research Corp. v. CBS, Inc., 793 F2d 1261,1272, 229 USPQ 805 (CAFC 1986)(circumstantial evidence of extensive sales, dissemination of an instruction sheet, and the availability of a solution booklet; defendant's assertion that without evidence of direct infringement it cannot be liable for inducing infringement must fail, since proof of inducing or direct infringement does not require direct, as opposed to circumstantial evidence). The evidence shows that AMD's technical literature provides and instructs how to make and use the 29300 and 29500 infringing structures, provides and instructs the infringing algorithms and programs computed by these structures and provides and instructs the hardware and software tools that can be used to program the infringing programs. See 1b supra.

7. Same as 6 supra.

8. Not relevant. Petitioner does not accuse that any individual part from AMD's 29300 and 29500 families includes the elements claimed in the 660 Patent. Rather, petitioner accuses that systems made using parts from AMD's 29300 and 29500 families includes the elements claimed in the 660 Patent. See DN 48; see footnote page 13 supra.

9. Same as 5 supra. When the accused 29300 and 29500 systems are programmed to compute a FIR filter they constitute the claimed time inversion system in the 660 Patent. See footnote page 13 supra.

10. Same as 9 supra.

11. Same as 6 supra. When the accused 29300 and 29500 systems are programmed to compute the FIR filter they constitute the claimed time inversion system in the 660 Patent. See footnote page 13 supra.

12. Same as 11 supra.

13 and 14. Same as 1 supra.

II. Non-Infringement of the 660 Patent Renders Moot Dispute as to Patent's Validity

The court's order filed 27 January,1989 (B-2) held that the 660 Patent was not infringed by AMD, and the court's order filed 16 March, 1989 (B-10) held that the 660 Patent was invalid under 35 USC 103. However, the court's order invalidating the 660 Patent (B-10) is error because the court's determination that the 660 Patent was not infringed by AMD renders moot dispute as to patent's validity. Advance Transformer Co. v. Levinson, 5 USPQ2d 1600,1603 (CAFC 1988)(Appelate court's determination that patent was not infringed renders moot dispute as to patent's validity, and the federal district court's holding that patent is invalid is therefore vacated).

III. The 660 Patent is Valid on Merits

The court applies the combination of the Constant Patent No. 3,950,635 ("635"), the Springer article, and Bird Patent No. 3,553,651 ("651") to invalidate the 660 Patent. The court finds that there are no differences between (1) the structure of the 660 Patent and the structure of the 635 Patent (B-15) and (2) the function of the 660 Patent and the function of the Bird 651 Patent.

In Constant v. AMD, 7 USPQ2d 1057 the court applies the A&W article, the Stalcup patent, and the Springer article to invalidate the 635 Patent. The court states that the Springer "article was found to have disclosed every element of the invention claimed in the 635 Patent, except the specific filter application contained in the Patent" (B-12) and "Mr.

Constant is collaterally estopped from relitigating the decision of the Circuit" (B-15).

1. No Reason Given for Combining References

In the court's view, it is sufficient if the structure and function of the 660 Patent are found in different references. This view is error because it fails to give a reason for combining references.*

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* This Court has established that before references can be combined there must be some reason for the combination other than that gleaned from the invention itself. Something in the prior art as a whole must support the desirability, and thus obviousness of making the invention. Uniroyal v. Rudkin-Wiley Corp., 5 USPQ2d 1434,1438 (CAFC 1988). It is impermissible to disregard portions of prior art reference that teaches away from invention. Akzo N.V. v. USITC, 908 F2d 1471,1481, 1 USPQ2d 1241,1246 (CAFC 1988) cert den 107 SCt 2490 (1987); W.L.Gore & Assoc. v. Garlock, Inc., 721 F2d 1540,1550, 220 USPQ 303,311 (CAFC 1983) cert den 469 US 851 (1984), At all costs, the mistake of picking random bits of various prior art references and employing them "as a mosaic to recreate a facsimile of the claimed invention must be avoided. Id 1552,312

2. Petitioner's 635 Patent Cannot Be Prior Art To Him

The 635 Patent is not prior art against the 660 Patent. Reading & Bates Construction Co. v. Baker Resources Co., 748 F2d 645, 223 USPQ 1168 (CAFC 1984); In re Fout, 213 USPQ 532 (CCPA 1982) ("Absent a statutory bar under 35 USC 102(b),(c) or (d), an applicant's own invention cannot be 'prior art' to him"). If the 635 Patent is withdrawn as prior art (as it should), there is no structure in the Springer and Bird references to apply against the 660 Patent.

3. Collateral Estoppel Does Not Apply

Collateral estoppel serves to preclude the relitigation by the same parties of issues actually litigated, and necessarily determined, in a prior proceeding, Lawlor v. National Screen Service Corp., 349 US 322, 75 SCt 865, 99 LEd 1122 (1955);

Chromalloy American Corp. v. Kenneth Gordon Ltd., 736 F2d 694, 222 USPQ 187 (CAFC 1984); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F2d 1566, 221 USPQ 394 (CAFC 1983); International Order of Job's Daughters v. Lindeburg & Co., 727 F2d 1087, 220 USPQ 1017 (CAFC 1984).

The issue of validity of the 660 Patent under 35 USC 103 considering the 635 Patent, the Springer article, and the Bird 651 Patent was never actually litigated, and necessarily determined, in Constant, supra in which different devices involving different facts and different prior art were determined. See footnote page 3 supra. Del Mar Avionics, Inc. v. Quinton Instrument Co., 5 USPQ2d 1255,1258 (CAFC 1987) ("A device not previously before the

court, and shown to differ from those structures previously litigated, requires determination on its own facts). Since the 660 Patent device was not previously before the court and since its structure and function differ from those structures and functions previously litigated, collateral estoppel does not apply and the issue of obviousness requires determination on its own facts.

4. The Tests for Obviousness Were Not Made

The courts below relied on Constant, supra to establish that the 660 Patent is invalid because "the 635 Patent reveals that every element found in the 660 Patent is also found in the 635 Patent, with the exception of the application, which recites time inversion" (B-14,15). The courts

below collaterally estopped the petitioner from relitigating the decision of the CAFC (B-15) and the CAFC denied petitioner's motion to file a supplement brief to revisit the earlier decision (A-3). Thus, the petitioner was denied any opportunity to point out that the collateral estoppel effects of the earlier case did not apply and/or to point out errors in the earlier decision. In Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 US 313, 169 USPQ 513 (1971), this Court set forth the rule that once a patent has been declared invalid via judicial inquiry, a collateral estoppel barrier is created against further litigation involving the patent, unless the patentee-plaintiff can demonstrate that he did not have a full and fair chance to litigate the validity of his patent in the earlier case. The

CAFC order (A-3) is error because it did not give petitioner the opportunity to demonstrate that he did not have a full and fair chance to litigate the validity of the 635 Patent in Constant, supra.

Rather, the differences between the 660 and 635 Patents, and obviousness, were determined not upon their own facts but upon the different facts and errors in Constant, supra. However, this Court has established that obviousness must be grounded on the four factual inquiries in Graham v. John Deere, 148 USPQ 459,467 (SCt 1966).

a. Scope and Content of the Prior Art

Section 103 applies when "the invention is not identically disclosed or described as set forth in Section 102". Under Section 102, references cannot be combined. In re Saunders, 444 F2d 599,602-03, 170 USPQ 213 (CCPA 1971). See also Studiengeselschaft

Kohle mbH v. Dart Indus., 549 FSupp 716, 216 USPQ 381 (D Del 1982) aff'd 726 F2d 724, 220 USPQ 841 (CAFC 1984)(citing Treatise). Under Section 103, the cited combination is considered as a whole not individually. Application of Fournet,357 F2d , 53 CCPA 1247 (1966)(Use of prior art teachings under this section requiring non-obvious subject matter as condition for patentability is a two-way street, available to both parties, and the court is required to evaluate references as a whole regardless of party offering references. Clearly, the combination of the Constant 635 Patent, Springer article, and Bird 651 Patent is not prior art under any subsection of Section 102. Moreover, the references taken singly are not prior art for the following reasons.

That the references taken singly are prior art because they antedate the 660

Patent is just one factor in the requirement under Section 102. The other factor is whether the "invention" was described in a reference identically (to anticipate under Section 102) or non-identically (to obviate under Section 103). In the latter case, the reference must have something in common as well as something different from the claimed invention. Indeed, the common part should teach or suggest the key element(s) of the claimed invention . In re Merchant, 575 F2d 865, 197 USPQ 785 (CCPA 1978), the court noted the difficulty in determining what in fact is prior art

> "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference , bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference". Id

A comparison of the claimed invention with each reference yields the facts that, first, no reference is in the claimed preamble, second, Springer and Bird do not disclose any claimed elements (*) and, third, Constant 635 discloses all claimed elements except the key claimed element for time reverse output sequence. Thus, Springer and Bird are not prior art because they do not fall within the claimed preambles and do not disclose any element of the claimed invention. Constant 635 is not prior art because an inventor's patent cannot be used to determine obviousness of his later invention. Reading & Bates, supra.

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* Springer's RAM is not the claimed digital delay RAM. See infra. Bird's FIFO and LIFO are not the claimed time or time-reverse output sequences from the claimed digital delay RAM (FIJO). See infra.

Moreover, Section 112 par. 6, which applies here, provides that means-plus-function language in a claim shall be construed to cover the structure described in the specification and equivalents thereof. Further, Section 112 requires identity of function absent which consideration of structure is not involved. Pennwalt Corp. v. Durand-Wayland, Inc., 4 USPQ2d 1737,1739 (CAFC 1987). If the required function of time inversion is not performed exactly, Section 112 par. 6 precludes the consideration of any structure in the references taken singly. Thus, it was error for the court to construe the structures in references to cover the 660 structure. The fact that references taken singly do not perform the same function denies the possibility that these references are

of the 660 Patent disclose convolution/correlation filters and time compressors using shift registers. Constant 635 discloses a time compressor using a RAM. Springer discloses a RAM replacing a shift register and Bird 651 discloses FIFO and LIFO data inputs and outputs of a storage memory.

From the foregoing it is clear that the 660 invention evolved from and is the first disclosure of a time inversion system in a convolution/correlation filter (Fig 2 in 660 Patent). Although the court concludes that the time reversal function would be obvious (B-16), it does not show that there is any teaching or suggestion in the prior art as a whole, that would lead one of ordinary skill to make the claimed time inversion system in a convolution/correlation filter (Fig 2 in 660 Patent).

b. Differences Between Prior Art and Claims at Issue

Constant 635 teaches all claimed elements except the time reversal function. The 660 Patent teaches and claims a digital delay RAM to obtain the output at each location of the delay line after 1,2, . . . N delays in a time compression filter (Fig 2 660 Patent). In contrast, Springer and Bird obtain their outputs FIFO or LIFO, i. e. data input is read out exactly N cycles later. The claimed output is neither FIFO or LIFO since for each input the output is obtained from any location J in the delay line RAM every N cycles (first-in-J-out) in the same or time reverse sequence. Springer and Bird operate memories at the same input and output (clock) rate. This feature alone makes the Springer and Bird memories unsuitable for use in the 660 Fig 2 filter which requires

low input rates and high output rates to obtain time compression. Finally, Springer and Bird do not suggest the claimed means for shifting the RAM after each sampling interval (as would be required in Fig 2 of the 660 Patent to obtain time compression). Because Springer's and Bird's memories operate their inputs and outputs at the same clock rate, they do not need and do not suggest the key claimed means for shifting the RAM after each sampling interval.

In short, the claimed invention has combined the structures and functions of time reversal and time compression used in filters. There is no suggestion for such combination in the Constant 635, Bird 651, and Springer references or in the prior art as a whole. The claims are construed in terms of the filter shown in Fig 2 of the 660 Patent. 35 USC 112 par. 6.

Although the court concludes that the combination of references does suggest the structure and function of the 660 Patent, it gives no reason for making the claimed combination of time reversal and time compression other than that gleaned from the invention itself, and the court does not discuss where in the prior art suggests the desirability, and thus the obviousness, of making the claimed combination of a time reversal and time compression functions. Uniroyal, supra 1438-39. The court impermissibly disregards portions of the Springer and Bird references that teach away from the invention (Springer's RAM and Bird's memory operate serial-in-serial out FIFO/LIFO with inputs and outputs at the same clock rate which precludes their use in the claimed means for shifting the RAM after each sampling interval of a filter). Akzo,W.L.

Gore, supra. The court impermissibly picks random bits and pieces of the Constant 635 Patent (digital delay RAM and means for shifting the RAM after each sampling interval), Springer article (RAM replacing a shift register without FIJO and without time reversal and time compression), and the Bird 651 (FIFO/LIFO memory without FIJO and without time compression) and employs them "as a mosaic to recreate a facsimile of the claimed invention". In shourt, the court reaches its conclusion (B-16 through B-19) on the basis of references that are not prior art, that do not suggest the claimed FIJO with time compression and without showing where in the prior art there is suggested the desirability, and thus obviousness of making the claimed combination of a time reversal and time compression functions. Uniroyal, supra 1438-39.

c. Level of Skill in the Pertinent Art

In determining the level of ordinary skill in the art, the factors are (1) the inventor's educational background, (2) type of problems encountered in the art, (3) solutions previously found, (4) the speed of innovation in the art, (5) sophistication of technology, (6) educational level of active workers in the field. Environmental Designs Ltd v. Union Oil Co., 713 F2d 693,696, 218 USPQ 865,868 (CAFC 1983) cert den 464 US 1043, 224 USPQ 520 (1984). Not all above factors may be present in every case, and one or more of these or other factors may predominate in a particular case. The important consideration lies in the need to adhere to the statute, i.e., to hold that an invention would or would not have been obvious to a person of ordinary skill in the art, not to a judge, or to a layman when it was made,

or to those skilled in remote arts, or to geniuses in the art at hand. Id 697, 868-69.

The invention was developed in 1974, thus establishing a reference point for determining the level of skill in the art. 35 USC 103; see Kloster Speedsteel AB v. Crucible, Inc., 793 F2d 1565,1574, 230 USPQ 81,86 (CAFC 1986) cert den 107 SCt 882 (1987). It is important to focus on the relevant time period to avoid viewing the invention through hindsight. W.L. Gore, supra 1553,313.

Applying these factors, there is nothing in the record to determine the educational level of the inventor or of active workers in the field, factors (1) and (6) supra. The remaining factors must be determined from the pertinent art which would reasonably be considered to

contain solutions to the problem facing the inventor at the time the invention was made. Standard Oil Co. v. American Cyanamid Co., 774 F2d 448,454,227 USPQ 293,297-98 (CAFC 1985).

The common problem encountered in incorporating the claimed time reversal feature in a filter, factor (2) supra, is to operate the input and output sampling rate of the filter's time compressor at different rates. Solutions found previously, factor (3) supra, do not exist because no one was motivated or had any reason to combine the time reversal feature into a filter's time compression system. * The speed of

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* Petitioner's motive to combine the time reversal feature into a filter's time compression system was to provide a convolver (filter) having twice the time resolution of existing correlation devises (col 5 line 14-16 660 Patent)

innovation, factor (4) supra, did not exist because no one in the prior art made a time inversion system for use in a time copression filter. Finally, while the sohistication of the technology, factor (5) supra, was high in the area of time compression filters, the filter art had not reached the sophistication to use time reversal in a time compression filter. It is reasonable therefore to assume that the level of skill in the pertinent art at the time the invention was made in 1974 while high in areas of time compression filters was nevertheless non-existent in the invention area of combining a time reversal feature into time compression filters (Fig 2 660 Patent).

The court's conclusion that "The level of ordinary skill in the art is that of an engineer with a BSEE who has had several years experience in the field of digital electronics" (B-14) is error because it is

not based upon any factual inquiry of the factors (1)-(6) supra but rests solely on the unsupported statement of AMD's expert witness (Frieden decl. 1 par 2 DN 69), a person of ordinary skill in the art in 1989 and, therefore, not adhering to the statute. Environmental Designs, supra 697,868-69. Moreover FRE 702 provides for use of expert testimony when it will "assist the trier of fact to understand the evidence or to determine a fact in issue". Here, expert Frieden provides no evidence to determine the level of skill at the time the invention was made in 1974 but only provides a statement as to what he thinks the level of skill is in 1989 through hindsight. Railroad Dynamics, Inc. v. A.Stucki Co., 218 USPQ 618 (ED Pa 1983) aff'd 220 USPQ 929 (CAFC 1984)(Burden of patent challenger is to prove facts supporting defenses,

not to prove legal conclusion of patent invalidity sought by these defenses).

d. Objective Evidence

The fourth consideration in an obviousness inquiry involves the study of objective evidence, so called "secondary considerations". These secondary considerations must be considered before a decision on obviousness is reached. Stratoflex, Inc. v.Aeroquip Corp., 713 F2d 1530,1538, 218 USPQ 871,879 (CAFC 1983). Furthermore, secondary considerations may be the most revealing evidence available, Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F2d 281,306, 227 USPQ 657,674-75 (CAFC 1985) cert den 475 US 1017 (1986); Custom Accessories, Inc. v. Jeffry-Allan Ind., 807 F2d 955,960, 1 USPQ2d 1196,1199 (CAFC 1986); W.L. Gore, supra 1555,314, and are entitled to great weight when the evidence is strong.

Simmons Fastener Corp. v. Illinois Tool Works, Inc., 739 F2d 1573,1576, 222 USPQ 744,747 (CAFC 1984) cert den 471 US 1065 (1985). See also Panduit Corp. v. Dennison Mfg Co., 810 F2d 1561,1569, 1 USPQ2d 1593, 1598 n.13 (CAFC 1987) cert den 107 SCt 2187 (1987)("In appraising an inventor's contribution to the art . . . the most reliable test is to look at the situation before and after it appears" quoting Safety Car Heating & Lighting Co. v. General Electric Co., 155 F2d 937,939, 69 USPQ 401,402 CA2 1946 L.Hand,J.).

Petitioner's contribution to the art is that the claimed time reversal feature was combined into a time compressor filter (Fig 2 660 Patent) to provide for high quality filters (col 5 lines 1-25 660 Patent). *

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* The Springer and Bird references cannot be applied to a time compression filter

The court's conclusion that "The objective evidence does not support a finding of non-obviousness" (B-19) is error because it is premature. The objective evidence cannot be established before the infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is determined. Clearly, if AMD infringes the 660 Patent then such evidence would be entitled to great weight (W.L. Gore, supra) and must be considered before a decision on obviousness is made (Stratoflex, supra).

i. There is an Issue Between the Parties as to Infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 Devices

The court's order filed 27 January, 1989 (B-2) held that the 660 Patent was not infringed by AMD's 29300 and 29500 systems, and the court's order filed 16 March, 1989 (B-10) held that the 660

Patent is invalid under 35 USC 103. The court's order filed 4 April, 1989 (B-21) held that the petitioner's motion for infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is determined by "previous orders entered in this action" (B-22). It is clear that petitioner's motion for infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices was not determined on the merits since the 660 Patent was found to be invalid by the court.

ii. <u>The Secondary Evidence of Infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 Devices was Not Considered Before the Decision on Obviousness of the 660 Patent was Reached</u>

The 660 Patent was held invalid under 35 USC 103 (B-10) before the secondary evidence of the infringement of the 660 Patent by AMD's 7910/11 and 79C12/14

devices was resolved (since commercial success would be established if AMD's products were shown to infringe the 660 Patent). Stratoflex, supra 1538,879 (Secondary considerations must be considered before a decision on obviousness is reached).

iii. The court's Judgement that the 660 Patent is Invalid Before a Full Adjudication of the Infringement of that Patent by AMD was Made is Error and Deprives Petitioner's Due Process

Since the court did not fully adjudicate the infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices, there is no infringement adjudication on appeal to protect the 660 Patent's validity when that patent in fact is not infringed by AMD. Advance Transformer, supra 1603 (Appellate court's determination that patent was

not infringed renders moot dispute as to patent's validity, and the federal district court's holding that patent invalid is therefore vacated). The absence of the full adjudication of the infringement of the 660 Patent by AMD by the court deprives petitioner's due process.

The test for obviousness under 35 USC 103 must include the objective evidence (B-13,14). Since commercial success of the invention would be established if AMD's products infringe the 660 Patent, the determination of infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is a material fact which must be considered before a decision on obviousness is reached. Stratoflex, supra.

The court's judgement that the 660 Patent is invalid before a full adjudication of that patent by AMD's 7910/11 and 79C12/14 devices denies petitioner a

hearing for infringement on merits to show that in fact the 660 Patent is infringed by AMD's 7910/11 and 79C12/14 devices and to thereby establish commercial success that makes the invention not obvious. Vlandis v. Kline, 412 US 441 (1973) (Students not given the opportunity to show that in fact they have become residents); Cleveland Board of Education v. LaFleur, 414 US 632 (1974)(Woman not given the opportunity to show that pregnancy does not incapacitate as a teacher).

III. The 458 Patent is Infringed by AMD's 9568, 9518 and 8068 devices

AMD infringes the 458 Patent because the 9568,9518,8068 devices each compute the encryption algorithm given in the Federal Register 17 March, 1975 in the identical or equivalent means described in elements 4 and 6b of Fig 5 of the 458 Patent. For identity of structure and function see EXHIBITS 1,2,3,4,5,6 in DN 82.

Claims of the 458 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The 9568,9518,8086 devices infringe claims 17,19,22,23,27,30 of the 458 Patent because every function of the claimed combination is performed by each accused

device, the structures performing those functions being identicals or equivalents of the structures described in the 458 Patent, literally under 35 USC 112 paragraph 6. Pennwalt, supra.

The court's order holding that the 458 Patent is not infringed by the 9568, 9518,8068 devices (B-21) is error because, first, claims require "memory means having storage locations for n words" and, second, claims require "stored outputs S_n,K_n representing at least one of delayed,encrypted, and decrypted signals K,S". The disclosure in the 458 Patent specifies "signals S_n,K_n where n=1,2,...N appear as inputs to algorithm computer 6b in RAM 30" (col 8 lines 19-20). The 9568, 9518, 8068 devices have signal K_n where n=1 and signals S_n,K_n appear as inputs to the algorithm computer. See EXHIBITS 1,2,3 in DN 82.

The court's finding that "Mr. Constant

is estopped from contending that the 458 Patent does not involve a memory device which stores more than one word" (B-26,27) is without merit since, once literal infringement is found, the doctrine of file wrapper estoppel is inapplicable. Loctite Corp. v. Ultraseal Ltd., 781 F2d 861,870, 228 USPQ 90,95 (CAFC 1985): Fromson v. Advance Offset Plate, Inc., 720 F2d 1565, 1571, 219 USPQ 1137,1141 (CAFC 1983). An analysis of the file wrapper estoppel doctrine, as well as purposes it is intended to serve illustrates the soundness of this conclusion.

File wrapper estoppel is an equitable doctrine designed to limit a patentee's use of the doctrine of equivalents. Exhibit Supply Co. v. Ace Patents Corp., 315 US 126, 136, 52 USPQ 275,279 (1942); Thomas & Betts Corp. v. Litton Systems, Inc., 720 F2d 1572,

1579-80, 220 USPQ 1,5-6 (CAFC 1983); Loctite, supra at 870; Hughes Aircraft Co. v. United States, 717 F2d 1351, 219 USPQ 473 (CAFC 1983); Caterpillar Tractor Co. v. Berco,SPA, 714 F2d 1110,1115, 219 USPQ 185,187 (CAFC 1983). By invoking the doctrine of equivalents, a patentee attempts to broaden the scope of his patent beyond the literal language of its claims. Graver Mfg Co. Inc. v. Linde Co., 339 US 605,608, 85 USPQ 328, 330 (1950); Hughes Aircraft Co., supra at 1361,480. To counter that thrust, the doctrine of file wrapper estoppel prevents the patentee from extending the scope of his patent to subject matter he previously surrendered. Exhibit Supply, supra at 136, 279; Hughes Aircraft Co., supra at 1362,48.

The doctrine of file wrapper estoppel is not applicable, however, where literal infringement has been found and the patentee

is, therefore, not relying upon the doctrine of equivalents. See e.g., Hughes Aircraft Co., supra at 1361,480 ("The doctrine of equivalents comes into play only when actual literal infringement is not present"). The doctrine of file wrapper estoppel does not apply in the present case because literal infringement is present.

The court's finding that "the 458 Patent requires that signal K be delayed, encrypted, or decrypted before being placed in the crypto means" (B-28) is incorrect since Fig 7 in the Patent clearly requires that signal K (input to RAM 40) be stored and delayed in RAM 40 (col 8 lines 11-15 disclose RAM 40 is a storing RAM; col 9 lines 59-66 disclose that RAM performs the function of a delay line) before signal K_n (output from RAM 40) is placed in the crypto means RAM 30. The

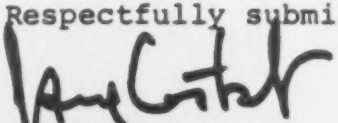
correct statement therefore is "the 458 Patent requires that signal K_n be delayed, encrypted, or decrypted before being placed in the crypto means". This requirement is always met since signal K is always encrypted or decrypted since signal K is the key for a clear or cipher signal S (col 8 lines 14-15) it may be enciphered or deciphered before or after it is placed in RAM 40 (col 8 lines 34-35 disclose RAMs 30 and 40 may be identical enciphering or deciphering RAMs). In either case, signal K_n, as claimed, represents "at least one of delayed, encrypted, and decrypted signal K". As claimed, accused devices store the cryptographic key in a second memory with n=1 word location (single stage delay register) the output of which represents at least one of a delayed, encrypted or decrypted signal K_1.

CONCLUSION

The petition should be granted because the court of appeals judgement (A-2) is in conflict with the decisions of the same and of other courts of appeals, and with the applicable decisions of this Court, on the same matter and because the court of appeals has so far departed from the usual proceedings as to call for an exercise of this Court's power of supervision.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the judgement (A-2) and order (A-3) of the United States Court of Appeals for the Federal Circuit.

Respectfully submitted



11/27/89

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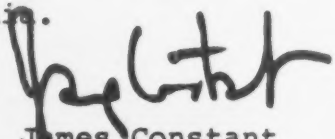
CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT and APPENDIX were served on the respondent by mailing first class Three (3) true copies to it on 27 November, 1989 addressed as follows

Skjerven, Morrill, MacPherson,
Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 27 November, 1989 at Claremont, California.



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